

Notice of Allowability

Application No.

10/658,246

Applicant(s)

ZIZZI, STEPHEN¹

Examiner

Art Unit

Justin T. Darrow

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to an amendment and declarations filed 04/11/2006.
2. ☒ The allowed claim(s) is/are 13, 19, 29, 31-35, 37, 38, 40-42, 44 and 45.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

1. Claims 1-45 have been presented for examination. Claims 1-12, 14, 20, and 23-28 have been canceled, claims 13, 15-19, 21, and 22 have been amended, and new claims 29-45 have been added in a preliminary amendment filed 05/13/2005. Claims 15-18, 21, 22, 30, 36, 39, and 43 have been canceled and claims 29, 31, 33, 34, 40, and 41 have been amended in an amendment filed 04/11/2006. Claims 13, 19, 29, 31-35, 37, 38, 40-42, 44, and 45 have been examined.

Priority

2. Acknowledgment is made that the instant application is a continuation-in-part of Application No. 09/259,991, filed 03/01/1999, now U.S. Patent No. 6,981,141 B1, which is a continuation-in-part of Application No. 09/074,191, filed 05/07/1998, now U.S. Patent No. 6,185,681 B1.

Allowable Subject Matter

3. Claims 13, 19, 29, 31-35, 37, 38, 40-42, 44, and 45 are allowed.

4. The following is an examiner's statement of reasons for allowance:

Claims 13, 15, 19, 29, 31, and 32; and 33-35, 37, and 38 are drawn to a process and a computer program product comprising a computer usable medium for decrypting documents, and claims 40-42, 44, and 45 are drawn to computer program product comprising a computer usable medium for encrypting documents. The closest prior art, Brundrett et al., U.S. Patent No. 6,249,866 B1, discloses such a method and computer program products. Although Brundrett et al., U.S. Patent No. 6,249,866 B1 anticipates claims 13, 19, 29, 31-35, 37, 38, 40-42, 44, and 45,

Art Unit: 2132

Brundrett et al. does not claim a first table having names of encrypted documents and, for each of the names of the encrypted documents, key names associated with the encryption key values for the encrypted documents. This particular feature explicitly incorporated into independent claims 29, 33, and 40 renders claims 13, 19, 29, 31-35, 37, 38, 40-42, 44, and 45 patentably distinct from any claim of Brundrett et al., U.S. Patent No. 6,249,866 B1 under the two-way test of 37 CFR § 1.601(n). See MPEP §§ 806.05(h) and 2301.02 and *Eli Lilly & Co. v. Board of Regents of the University of Washington*, 67 USPQ2d 1161, 1164 (Fed. Cir. 2003). Further, this particular feature renders the rejection of the claims 13, 19, 29, 31-35, 37, 38, 40-42, 44, and 45 under 35 U.S.C. § 102(e) based on Brundrett et al., U.S. Patent No. 6,249,866 B1 eligible to be overcome by a declaration under 37 CFR § 1.131. See 37 CFR § 1.131(a)(1) and MPEP § 715. The Declaration of Stephen Zizzi (Second) (inventor), Paper No. AF/D (04/11/2006), filed 04/11/2006, in combination with exhibits, the Declaration of Christopher W. Mahne, Paper No. AF/D (04/11/2006), filed 04/11/2006, and the Declaration of Paul Halpern, Paper No. AF/D (04/11/2006), filed 04/11/2006, both declarations under 37 CFR § 1.132, clearly show completion of the invention, including an actual reduction to practice, of claims 13, 19, 29, 31-35, 37, 38, 40-42, 44, and 45 before 09/01/1997 before the effective filing date of 09/16/1997 of Application No. 08/931,774, maturing into issued patent, Brundrett et al., U.S. Patent No. 6,249,866 B1. See MPEP § 715.07 I. The actual reduction to practice and sale of the invention of claims 49-56 before 09/01/1997 is corroborated in the Declaration of Christopher W. Mahne (Second) (President of MAZ Technologies, Inc., the patent owner), Paper No. AF/D (04/11/2006), filed 04/11/2006, and the Declaration of Paul Halpern (representative of the customer, Lyon & Lyon), Paper No. (04/11/2006), filed 04/11/2006. Thus, these declarations are sufficient to show the reduction to practice of the invention of claims 13, 19, 29, 31-35, 37, 38,

Art Unit: 2132

40-42, 44, and 45 before the effective date of Brundrett et al., U.S. Patent No. 6,249,866 B1 to overcome the rejection under 35 U.S.C. § 102(e) based on this reference. See MPEP § 715.07 III. (A). The next closest prior art, Blaze, "A Cryptographic File System for Unix," discloses similar methods and program products. However, Blaze neither teaches nor suggests a first table having names of encrypted documents and, for each of the names of the encrypted documents, key names associated with the encryption key values for the encrypted documents. This distinct feature explicitly recited in independent claims 29, 33, and 40 renders claims 13, 15, 19, 29, 31, and 32; 33-35, 37, and 38; and claims 40-42, 44, and 45, respectively, allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (571) 272-3801, and whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (571) 272-3799.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal


Art Unit: 2132

papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed **"OFFICIAL FAX"**. Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only **"OFFICIAL FAX"** but also **"AMENDMENT AFTER FINAL"**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

May 1, 2005


JUSTIN T. DARROW
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100